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EXAMINER

FOSTER, ROLAND G

ART UNIT

PAPER NUMBER

2645

DATE MAILED: 11/30/2001

11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/232,289

Applicant(s)

BJORND AHL, PER

Examiner

Pablo N Tran

Art Unit

2684

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 2, 16-26 and 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-15, 27-29 and 31-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, 3-12, 27-29, and 31-32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-32 of copending Application No. 09/022,289. Although the conflicting claims are not identical, they are not patentably distinct from each other because they disclosed a communication system for secure wireless communications..

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3-15, 27-29, and 31-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Israelsson* (5,479,595) in view of *Felsenstein* (5,608,723).

As per claims 1, 3, 8, 10, 16, 27, and 31, *Israelsson* disclosed a mobile telephony system capable of switching signal transmissions of mobile station (first device) and base station (second device) between RF (second communication mode) and IR (first communication mode) signals. It is obvious when a mobile station is near a light Tx/Rx point (LXP), within range of the base station, the base station send a IR request command to the mobile station to switch over, handoff, from RF wave to an IR channels to avoid disturbance (abstract, fig. 1-6, col. 2/ln. 46-col. 3/ln. 30, col. 4/ln. 10-col. 6/ln.46).

Israelsson disclose Applicant's invention except teaching prior to transceiving a security message therebetween, said first and second devices switch transceiving to said first communication mode, and transmit said security message in said first communication mode. *Felsenstein* disclosed transceiving a code, security, message therebetween said first communication mode. Whether the communication is in RF or IR mode, the transmission of the code, security, message is always switched over to IR mode (fig. 2-3, col. 3/ln. 25-col. 4/ln. 62). Therefore, it would have been obvious to one of ordinary skill in the art to modify and apply a systems for secure wireless

communication as taught by *Felsenstein* to a mobile telephony system as taught by *Israelsson* in order to transmit security messages in infrared signal to prevent unauthorized listeners.

As per claims 4, 7, 19, and 32, the combination of *Israelsson* and *Felsenstein* disclosed wherein said security message comprises a plurality of encryption keys for the subsequent encryption of a plurality of said messages transceived in said second communication mode (see *Felsenstein*, fig. 2-3, col. 3/ln. 25-col. 4/ln. 62).

As per claim 5, *Israelsson* further disclosed wherein upon said mobile station switching said transceiving to said first communication mode, said second device transmits an infrared request message to said first device (fig. 6, col. 5/ln. 12-46).

As per claim 6, the combination of *Israelsson* and *Felsenstein* disclosed wherein said first device, upon receipt of said infrared request message, transmits said security message to said second device (see *Felsenstein*, fig. 2-3, col. 3/ln. 25-col. 4/ln. 62).

As per claim 12, the combination of *Israelsson* and *Felsenstein* further disclosed wherein said communication system is a cordless system (see *Felsenstein*, abstract, fig. 1-4, col. 3/ln. 6-col. 5/ln. 40).

As per claim 9, 11, and 28, *Israelsson* further disclosed wherein said infrared transmission means comprises:

- a photo detector (fig. 6/no. 33, see *Felsenstein*, fig. 3/no. 50) for receiving said infrared transmissions; and
- an infrared emitter (fig. 6/no. 32, see *Felsenstein*, fig. 3/no. 44) for transmitting said infrared transmissions.

As per claims 13, 24, and 33, *Israelsson* further disclosed wherein said first and second devices are each selected from the group consisting of: mobile telephone, home base stations, SIM cards, heads sets, computers, printers, plotters, projectors, facsimile devices, pagers, data organizers, computer terminals, scanners, microphones, PC cards, televisions, radios, stereos, VCRS, light devices, dimmers, thermostats, doors, refrigerators, freezers, ovens, washers, dryers, answering machines, home alarms, car alarms, and other peripheral and portable devices (abstract, fig. 1-2, col. 2/ln. 6-18).

As per claims 14, 25, and 34, *Israelsson* further disclosed wherein said first and second devices communicate on a radio frequency band range from about 2.4 GHZ to about 2.483 GHZ (abstract, fig. 1-2, col. 5/ln. 47-col. 8/ln. 13).

As per claims 15, 26, and 35, *Israelsson* further disclosed wherein said band is at about 2.45GHZ (abstract, fig. 1-2, col. 5/ln. 47-col. 8/ln. 13).

As per claim 17, 20, the combination of *Israelsson* and *Felsenstein* disclosed wherein prior to said establishment of said secure communication link, said first and second operated in said radio frequency mode (see *Felsenstein*, fig. 2-3, col. 3/ln. 25-col. 4/ln. 62).

As per claim 18, *Israelsson* further disclosed wherein in said step of forwarding, said first device forwards said infrared request message to said second device, and said second device, upon receipt of said infrared request message, replies with an infrared reply message (fig. 6, col. 5/ln. 12-46).

As per claim 21, the combination of *Israelsson* and *Felsenstein* disclosed forwarding, from said second device, a security poll signal to said first device (see *Felsenstein*, abstract, fig. 2-3, col. 3/ln. 25-col. 4/ln. 62).

As per claims 22 and 23, the combination of *Israelsson* and *Felsenstein* disclosed wherein the security poll signal occurs periodically and randomly (see *Felsenstein*, abstract, fig. 2-3, col. 3/ln. 25-col. 4/ln. 62).

As per claim 29, *Israelsson* further disclosed wherein said infrared emitter comprises a light-emitting diode (fig. 6, col. 5/ln. 12-46, see *Felsenstein*, fig. 1-4, col. 3/ln. 6-col. 5/ln. 40).

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pablo Tran whose telephone number is (703)308-7941. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Hunter, can be reached at (703)308-6732.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

November 14, 2001

Pablo Tran

Examiner, Art Unit 2684



DANIEL HUNTER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600